

REMARKS

In an Office Action mailed on April 23, 2003, claims 1-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harwer in view of Woychik; claims 6, 7, 10-12 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harwer in view of Ma; claims 15 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dell in view of Pope; claims 18, 19 and 25-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dell in view of Pope and Ma; claims 17 and 20-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dell in view of Pope and Volz; claims 8 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harwer, Ma and Dell; and an objection was made to claim 9 as pending upon a rejected base claim but allowable if rewritten in independent form.

On page 3 of the Office Action, the Examiner groups claim 9 with other claims that are rejected under 35 U.S.C. § 103(a) as being unpatentable over Harwer and Ma. However, the Examiner does not specifically address the rejection of claim 9 and indicates on page 8 as well as on the cover sheet of the Office Action that claim 9 is allowable if rewritten in independent form. For purposes of this Reply, it is assumed that claim 9 is allowable if rewritten in independent form. Therefore, claim 9 has been rewritten in independent form as independent claim 31; and thus, it is submitted that claims 31-34 are patentable over the cited art. Furthermore, newly added claims 35-41 are patentable in view of the cited art. The §§ 102 and 103 rejections are addressed below.

Rejections of Claims 1-5:

The Examiner maintains the § 103(a) rejection of independent claim 1 in view of the combination of Harwer and Woychik. However, the Examiner fails to show where the prior art allegedly teaches a circuit board that includes uniformly spaced contacts to communicate power that are separated by a first distance and uniformly spaced contacts to communicate signals and not communicate power that are separated by a second *different* distance. Thus, even assuming that the combination of Harwer and Woychik is proper, the Examiner fails to show where the prior art teaches or suggests all claim limitations.

"Obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Thus, the Examiner must show, with specific citations to the prior art, where the prior art teaches or suggests the claim limitations. *See Ex*

parte Gambogi, 62 USPQ2d 1209, 1212 (Bd. Pat. App. & Int. 2001); *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2143. Without such a showing, the Examiner fails to establish a *prima facie* case of obviousness for independent claim 1.

Furthermore, a *prima facie* case of obviousness requires more than the Examiner finding the various elements of a claim in different references. In this manner, a *prima facie* case of obviousness requires the Examiner to show where the prior art contains the alleged suggestion or motivation for the combination/modification of references. Thus, in the instant case, the Examiner fails to show where the prior art contains the alleged suggestion or motivation to combine Harwer and Woychik. Furthermore, the Examiner fails to show where the prior art contains the alleged suggestion or motivation to modify Harwer's circuit board to derive the missing claim limitations. Therefore, for at least these reasons, the Examiner fails to establish a *prima facie* case of obviousness for independent claim 1.

Claims 2-5 are patentable for at least the reason that these claims depend from an allowable claim.

Rejections of Claims 6-10:

In the latest Office Action, the Examiner concedes, "Harwer does not teach the substrate having an edge profile engage by the connector housing assembly to resist removal of the circuit board from the connector housing assembly." Office Action, 4. Therefore, the Examiner relies on Ma to teach the missing claim limitations. As pointed out above in the discussion of independent claim 1, a *prima facie* case of obviousness requires more than just a combination of elements from various references. Rather, the Examiner must show where the prior art contains the alleged suggestion or motivation to combine and/or modify references to derive the claimed invention. *See, for example, Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (Bd. Pat. App. & Int. 2001); *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2143.

Additionally, there is not a proper rationale to combine Harwer and Ma to reject amended independent claim 6 under 35 U.S.C. § 103(a). In this manner, Ma discloses a locking member located on the *outside* of a slot housing 10. Therefore, not only does Ma fail to teach the limitations of amended independent claim 6, Ma teaches away from the claimed invention and therefore, Ma cannot be used to establish a *prima facie* case of obviousness for independent claim 6. M.P.E.P. § 2145 X.D.

Claims 7-10 are patentable for at least the reason that these claims depend from an allowable claim.

Rejections of Claims 11-14:

Claims 11-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Harwer and Ma. However, as amended, the method of claim 11 recites forming a profile in the substrate to engage a slot connector housing inside the slot connector housing to hold the circuit board in the slot connector housing. Thus, as Ma teaches a locking member that is located outside of a connector housing, Ma fails to teach or suggest the missing claim limitations. Furthermore, Ma teaches away from the claimed invention, thereby making it improper to combine Ma with Harwer to derive a *prima facie* case of obviousness for independent claim 11. M.P.E.P. § 2145 X.D. Additionally, the Examiner fails to show where the prior art contains the alleged suggestion or motivation to combine Ma and Harwer and modify Harwer as set forth in the Examiner's rejection. Therefore, for at least any one of these reasons, a *prima facie* case of obviousness has not been established for independent claim 11.

Claims 12-14 are patentable for at least the reason that these claims depend from an allowable claim.

Rejections of Claims 15-20:

The Examiner rejects claims 15-20, "since using a known material having a specific optimum value would have been an obvious matter of design choices and it has not given any patentable weight." Office Action, 8. However, this is clearly improper, as all claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03; *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970) (stating "all words in a claim must be considered in judging the patentability of that claim against the prior art"). "Obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Rather, the Examiner must show where the prior art teaches or suggests the claimed invention. Because the Examiner has failed to fulfill this requirement, a *prima facie* case of obviousness has not been established for claims 15-20 for at least this reason.

Rejections of Claims 21-24:

The method of independent claim 21 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Pope and Volz. However, a *prima facie* case of obviousness requires more than just a piecewise combination of elements from various references. In this manner, the Examiner must show where the prior art contains the alleged suggestion or motivation to modify Dell so that the connector housing of Dell has films. Without such a suggestion or motivation, a *prima facie* case of obviousness has not been established. *See, for example, Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (Bd. Pat. App. & Int. 2001); *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2143; *W.L. Gore & Associates, Inc v. Garlock, Inc.*, 220 USPQ 303, 312-13 (Fed. Cir. 1983) (stating, "to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against his teacher"); *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999) (stating, "rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment"). Therefore, for at least these reasons, the Examiner fails to establish a *prima facie* case of obviousness for independent claim 21, and thus, withdrawal of the § 103 rejections of claims 21-24 is requested.

Rejections of Claims 25-30:

The Examiner rejects independent claim 25 and independent claim 28 under 35 U.S.C. § 103(a) in view of the combination of Dell, Pope and Ma. However, as pointed above, Ma teaches a locking member that is located *outside* of a connector housing, not located *inside* the connector. Therefore, Ma fails to teach or suggest the missing claim limitations not taught by either Dell or Pope. Furthermore, as Ma teaches away from the claimed invention, Ma is not combinable with these references for purposes of establishing a *prima facie* case of obviousness for independent claim 25. Additionally, the Examiner fails to show where the prior art contains the alleged suggest or motivation to combine Pope, Dell and Ma. Therefore, for at least any of these reasons, the Examiner fails to establish a *prima facie* case of obviousness for independent claim 25.

Claims 26, 27, 29 and 30 are patentable for at least the reason that these claims depend from allowable claims.

CONCLUSION

In view of the foregoing, withdrawal of the §§ 102 and 103 rejections and a favorable action in the form a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees, or credit any overpayment to Deposit Account No. 20-1504 (ITL.0519US).

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Respectfully submitted,

Fred G. Pruner, Jr.
Registration No. 40,779
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, TX 77024
(713) 468-8880 [Phone]
(713) 468-8883 [Fax]